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Docket No. 10012237-1

## REMARKS

### I. PRELIMINARY REMARKS

Claims 4, 12 and 23 have been amended. Claim 35 has been added. No claims have been canceled. Claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26 and 30-35 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. REJECTIONS UNDER 35 U.S.C. § 103

#### A. The Rejections

Claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26 and 30-34 have been rejected under 35 U.S.C. § 103 as being unpatentable over combined teachings of the Brownlee patent (U.S. Patent No. 6,282,303) and the Yamada patent (U.S. Patent No. 6,560,612). The rejection under 35 U.S.C. § 103 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

#### B. The Standard of Evaluation

With respect to the legal standard upon which patentability under 35 U.S.C. § 103 is evaluated, *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), provides a fairly succinct summary of the standard adhered to by the Federal Circuit:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed

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invention may often be found in the prior art. However, ***identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.***

[Citations omitted, emphasis added.] The *Kotzab* decision is also cited in Section 2143.01 of the Manual of Patent Examining Procedure.

**C. Discussion Concerning Claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26 and 30-34**

Independent claims 1, 9 and 16 call for respective combinations of elements including, *inter alia*, "an at least partially transparent roller" and "a touch pad, adjacent to the roller, adapted to move a pointer on the display." The combinations defined by claims 3-5, 7, 30 and 32 include the elements recited in claim 1, the combinations defined by claims 11-13, 31 and 33 include the elements recited in claim 9, and the combinations defined by claims 17-19, 22-26 and 34 include the elements recited in claim 16. The cited references fail to teach or suggest such combinations.

The Brownlee patent discloses a cursor control device 1110, including a transparent roller and an imaging device, on a keyboard 1120. The cursor control device 1110 may be used to perform the primary function of a mouse, i.e. controlling the position of a cursor on the associated computer screen. [Column 5, lines 1-10; and column 7, lines 14-48.] When this function is being performed, the imaging device is used to detect movement of the user's finger relative the transparent roller. The cursor control device 1110 may also be used for fingerprint scanning.

The Yamada patent discloses a portable computer with a touchpad 11 and left and right buttons 12 and 13. The Yamada patent indicates that, because it is inconvenient to carry a separate mouse, touch pads are frequently provided on portable computers. [Column 1, lines 22-32.] The Yamada patent also indicates that the touch pad 11 is used

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to control the position of a pointer on the associated computer screen. [Column 4, lines 26-28.]

The Office Action has apparently taken the position that one of skill in the art would have been motivated to add the Yamada touch pad 11 to the Brownlee keyboard 1120 in order "to enhance the flexibility of the user interface system by providing the user with the capability of selecting various configurations selectively to satisfy functional and personal preferences." This position is respectfully traversed, as is the conclusion of obviousness based thereon.

First, there is nothing in the references themselves that provides a basis for the position taken in the Office Action. The references merely show that individual parts of the claimed combinations were in existence. The references do not show that it would have been obvious to combine these parts in the manner recited in the independent claims.<sup>1</sup> Instead, the sole basis for the rejection is a conclusory statement concerning "enhanced flexibility" and "user choice" that could be applicable to just about any two structures in any situation. Applicant respectfully submits that a finding of obviousness requires more.

Second, and more importantly, the Office Action failed to provide any support for the proposition that a skilled artisan would have been motivated to add a touch pad that is used to perform a mouse-like pointer control function (such as the Yamada touch pad 11) to a keyboard (such as the Brownlee keyboard 1120) which already has a device that is capable of performing this function (i.e. the cursor control device 1110). Applicant hereby requests that the Examiner specifically address this aspect of the proposed Brownlee/Yamada combination if the rejection is maintained in order to clarify the issues in the application.

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<sup>1</sup> 35 U.S.C. § 103 requires an analysis of the claimed invention as a whole, i.e. an analysis of the claimed **combination**. Even where the claimed invention is comprised of individual components well known at the time of invention, "[w]hat must be found obvious to defeat the patent is the claimed combination." *The Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). Thus, "[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

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As the combined teachings of the Brownlee and Yamada patents fail to teach or suggest the respective combinations of elements recited in independent claim 1, 9 and 16, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness with respect to claims 1, 3-5, 7, 9, 11-13, 16-20, 22-26 and 30-34. The rejection under 35 U.S.C. § 103 is, therefore, improper and should be withdrawn.

**D. Additional Discussion Concerning Claims 5, 13, 22, 23, 30 and 31**

The respective combinations defined by claims 5, 13 and 23 include, *inter alia*, "a touch pad," "a plurality of keys together defining a keyboard" and a "roller [that] is located between the touch pad and the keyboard." Even assuming for the sake of argument that there was some reason to add a touch pad to the Brownlee keyboard, one of skill in the art would not have positioned the purportedly obvious touch pad such that the cursor control device 1110 was located between the touch pad and the keys. As Figure 11 of the Brownlee patent clearly shows, such an arrangement would result in a touch pad that is about the size of a "shift" key crammed into the space between the cursor control device 1110 and the edge of the keyboard. Such a touch pad would not be particularly useful for mouse-like cursor/pointer control functions.

Similarly, the respective combinations defined by claims 22, 30 and 31 include, *inter alia*, "a roller," "right click and cleft click buttons" and a "touch pad [that] is located between the right click and left click buttons and the roller." Even assuming for the sake of argument that there was some reason to add a touch pad and right click and left click buttons to the Brownlee keyboard, one of skill in the art would not have positioned the purportedly obvious touch pad and right click and left click buttons such that the touch pad was between right click and left click buttons and the cursor control device 1110. As Figure 11 of the Brownlee patent clearly shows, such an arrangement would result in a touch pad and right click and left click buttons that are either crammed into the space between the cursor control device 1110 and the edge of the keyboard, or crammed into the space between the keyboard keys and the cursor control device 1110. Here too, the

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purportedly obvious additions to the Brownlee keyboard would be too small to be particularly useful.

Accordingly, for reasons in addition to those discussed above with respect to independent claims 1, 9 and 16, the rejection of claims 5, 13, 22, 23, 30 and 31 under 35 U.S.C. § 103 is improper and should be withdrawn.

### **III. NEWLY PRESENTED CLAIM 35**

Newly presented claim 35 depends from independent claim 16 and, accordingly, is patentable for at least the same reasons as claim 16.

### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 08-2025. Should such

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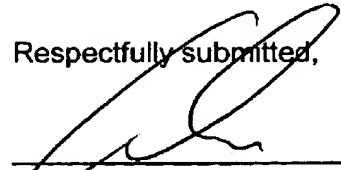
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fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

11/28/05  
Date

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Respectfully submitted,

  
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